

### **Remarks**

This communication is considered fully responsive to the Office Action mailed August 9, 2005 and made Final (hereinafter referred to as the "Final Office Action). Applicant appreciates the examiner removing the Notice of Non-Compliant Amendment included with the Office Action previously mailed on July 13, 2005 (later withdrawn/vacated).

In the Final Office Action, Claims 1, 4-12, and 14-27 were examined. Claims 1, 4-12, and 14-27 stand rejected. No claims are amended. No claims are cancelled. No new claims are added. Reexamination and reconsideration of claims 1, 4-12, and 14-27 are respectfully requested.

### **Premature Final Rejection**

The examiner erred in making this Office Action final because new grounds of rejection were introduced in the Final Office Action that were not necessitated by Applicant's amendment.

The Final Office Action rejected claims 1 and 12 under section 101 as being directed to non-statutory subject matter. Specifically, the Final Office Action states that "the use of a computer has not been indicated" and "the use of a computer is not evident in the claim." Applicant notes that claims 1 and 12 as originally filed referred to a multifunction device and did not recite "a computer," nor did any of the amendments change this, yet the examiner did not reject these claims under section 101 in any of the prior Office Actions.

The examiner's supervisor, Shahid Alam, did make mention of a *possible* section 101 rejection during the telephone interview with Applicant's

attorney, Mark Trenner, on April 11, 2005. *See, e.g.*, the examiner's Interview Summary mailed April 14, 2005 stating that "Applicant will submit amendment to clarify *possible* 35 U.S.C. 112 First, Second, and *possible* 35 U.S.C. 101 problems" (emphasis added)." However, no formal rejection was ever made nor could Applicant find any support for a section 101 rejection.

Introducing the section 101 rejection in this Office Action for the first time constitutes new grounds of rejection. The new grounds of rejection were not necessitated by Applicant's amendment. Therefore, Applicant respectfully requests withdrawal of the finality of this Office Action pursuant to MPEP 706.07(d).

#### **Telephone Interview**

Applicant appreciates the telephone interview afforded the undersigned attorney, Mark Trenner, on July 29, 2005, with the examiner. During the telephone interview, Mr. Trenner explained that he did not find any reason for the Notice of Non-Compliant Amendment and believed it was included in error with the Office Action mailed on July 13, 2005. The examiner said that he would review the file and withdraw the Office Action with Notice of Non-Compliant Amendment if it was indeed sent in error.

Applicant appreciates the examiner withdrawing/vacating the Office Action with Notice of Non-Compliant Amendment and issuing the present Office Action in its place.

### **Supplemental Information Disclosure Statement**

Applicant respectfully requests consideration of the supplemental information disclosure statement submitted herewith.

### **Claim Rejections - 35 U.S.C. 101**

The Final Office Action rejected claims 1 and 12 under 35 U.S.C. 101 as being directed to non-statutory subject matter. Applicant respectfully traverses this rejection.

The Final Office Action states that claims 1 and 12 are not statutory “because they merely recite a number of computing steps without producing any tangible result and/or being limited to a practical application within the technological arts.”

Claim 1 positively recites “identifying said user-specified remote storage device . . . establishing a link between said multifunction device and a user-specified remote storage device . . . accessing said electronic document . . . [and] sending said electronic document from said multifunction device. Not only do these recitations include a tangible result (i.e., an electronic document is accessed and sent), but these recitations are also limited to a practical application within the technological arts (i.e., accessing an electronic document and sending it from a multifunction device).

Claim 12 positively recites “identifying a remote storage device . . . [and] retrieving said user-requested document from said configured multifunction device.” Not only do these recitations include a tangible result

(i.e., a document is retrieved), but these recitations are also limited to a practical application within the technological arts (i.e., retrieving a document from a configured multifunction device).

The Final Office Action also states that “these claims do not indicate use of hardware on which the software runs to perform the steps recited in the body of the claim. Claim 1 positively recites “a multifunction device” and claim 12 positively recites “a configured multifunction device.” The term “multifunction device” is well understood in the computer consumer products industry as a type of computing device, and therefore is known to have or otherwise be associated with computer-readable media for computer-readable program code. However, if there is any question as to whether the multifunction device includes hardware on which the software runs to perform the recited steps, Applicant’s specification explains that multifunction devices are provided with computer-readable media and computer-readable program code. *See, e.g.*, page 6, lines 13-25.

The Final Office Action also states that “the use of a computer has not been indicated” and “the use of a computer is not evident in the claim.” The sections of the MPEP that the examiner cited do not require that the term “computer” be recited in order to be considered statutory subject matter. As noted above, multifunction devices are well-known in the industry as a type of computing device.

For at least the foregoing reasons claims 1 and 12 are believed to be directed to statutory subject matter and Applicant respectfully requests withdrawal of the section 101 rejection of claims 1 and 12.

### **Claim Rejections - 35 U.S.C. 102**

The Final Office Action rejected claims 1, 4-12, and 14-27 under 35 U.S.C. 102(e) as being unpatentable over U.S. Patent No. 6,557,907 to Czyszczewski, et al. (hereinafter referred to as “Czyszczewski”). Applicant respectfully traverses this rejection.

Invalidity for anticipation requires that a single prior art reference disclose each claim recitation. *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 USPQ2d 1001 (Fed. Cir. 1991). Every element must be literally present, arranged as in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)

Claim 1 positively recites “identifying said user-specified remote storage device having said electronic document based at least in part on a path thereto specified by a user at said multifunction device.” The cited references fail to teach or suggest at least these recitations.

The Office Action cites to Czyszczewski at col. 3, lines 11-17, which states:

*“The teachings herein also provide an ability to dynamically and bidirectionally integrate remote datastores or databases, and provide access to the information locally or remotely. These teachings also support the exchange of information so*

*that the multifunction device can retrieve information from,  
and insert information into, remote datastores.”*

Although this citation discloses the multifunction device accessing remote datastores, there is no teaching of a user-specified remote storage device.

The Office Action also cites to Czyszczewski at col. 9, line 60 to col. 10, line 3, which states:

*“The multifunction controller 25 also has the ability to accept downloads of various characteristics of the databases 150, for providing an efficient use of the global network 50. For example, the corporate directory database 185 may generate an index on a periodic basis and download the index to the multifunction controller 25, thereby allowing the multifunction device controller 25 to quickly determine the location of corporate directory information for a particular user. Index generation may be initiated by either a particular one of the databases 150, or by the multifunction controller 25 itself on a periodic basis.”*

Although this citation discloses accepting downloads from a remote database 150, there is no teaching of a user-specified remote storage device. To the contrary, Czyszczewski goes on to clarify index generation, query cycles, and other types of database administrative functions, including access by the multifunction controller is controlled by the remote administrator’s database, e.g., at col. 10, lines 16-20:

*“For example, it may be desirable for the multifunction controller 25 to have access to only a subset of the databases 150 that are provided as part of the global optional services 55. This limited access is controlled by the remote administrator’s database 200.” [Emphasis added].*

Czyszczewski discloses a form of automated database access. Czyszczewski also explains how the user can retrieve a document from a remote datastore using predetermined links to the remote datastores. See, e.g., col. 11, lines 20-21 (providing access to a predetermined corporate directory), and col. 11, lines 1-12 (requiring the user to first upload documents to the multifunction device and then go through a security protocol at the multifunction device to access the documents already uploaded to the multifunction device). However, there is no teaching or suggestion of identifying a user-specified remote storage device based at least in part on a path specified by a user

For at least the foregoing reasons claim 1 is believed to be allowable over the cited reference and Applicant respectfully requests withdrawal of the rejection of claim 1.

Claims 4-11 depend from claim 1, which is believed to be allowable. Therefore, claims 4-11 are also believed to be allowable for at least the same reasons as claim 1 and withdrawal of the rejection of claims 4-11 is respectfully requested.

Claim 5 positively recites “combining said document in electronic format with said electronic document from said user-specified remote storage device.” The cited references fail to teach or suggest at least these recitations.

The Office Action relies on Czyszczewski at col. 10, lines 59-60, which states:

*“The multifunction device 10 may also check the website periodically to ensure that it has a current list of documents.”*

This citation discusses having access to the latest versions of documents to be printed, faxed or e-mailed on demand. However, there is no teaching or suggestion that an electronic document from the user-specified remote storage device is combined with a document converted to electronic format at the multifunction device.

The Office Action also relies on Czyszczewski at Col. 6, lines 53-59, which states:

*“Databases A, B, and C (57, 60, and 65, respectively) may respectively store information regarding, for example, user profiles, user identifications and forms, that is, copies of commonly used documents in electronic format. Servers 70, 73, and 75 may include, for example, a print server 70, a fax server 73 and an e-mail server 75. . . .”*

However, there is no disclosure of converting a document to electronic format at the multifunction device and then combining the document with an electronic document from a user-specified remote storage device. The Office



Action is reading more into the Czyszczewski reference than is actually disclosed. For at least these reasons, claim 5 is believed to be allowable.

Claim 6 positively recites “combining said electronic document from said user-specified remote storage device with an electronic document generated at said multifunction device.” The cited references fail to teach or suggest at least these recitations.

The Office Action relies on Czyszczewski at col. 10, lines 48-60. This citation discusses having access to the latest versions of documents to be printed, faxed or e-mailed on demand. However, there is no teaching or suggestion that an electronic document from the user-specified remote storage device is combined with a document converted to electronic format at the multifunction device. For at least these reasons, claim 6 is believed to be allowable.

Claim 12 positively recites “identifying a remote storage device having a user-requested document based at least in part on a path for said remote storage device specified by a user at said configured multifunction device.” Again, the Office Action relies on Czyszczewski at col. 3, lines 11-17. As discussed in detail above for claim 1, these citations do not teach or suggest at least the recitations of claim 12.

For at least the foregoing reasons claim 12 is believed to be allowable over the cited references and Applicant respectfully requests withdrawal of the rejection of claim 12.

Claims 14-20 depend from claim 12, which is believed to be allowable. Therefore, claims 14-20 are also believed to be allowable for at least the same

reasons as claim 12 and withdrawal of the rejection of claims 14-20 is respectfully requested.

Claim 15 is also believed to be allowable for at least the same reasons as discussed above for claim 5.

Claim 16 is also believed to be allowable for at least the same reasons as discussed above for claim 6.

Claim 21 positively recites “including program code for identifying data operatively associated with a user-specified remote storage device; and program code for accessing said data operatively associated with said user-specified remote storage device from said multifunction device” (emphasis added). Czyszczewski fails to teach or suggest at least these recitations.

Again, the Office Action relies on Czyszczewski at col. 9, line 60 to col. 10, line 3. As discussed in detail above for claim 1, these citations do not teach or suggest at least the recitations of claim 12.

Czyszczewski implements a predetermined remote datastore (i.e., “the corporate directory database”). *See, e.g.*, col. 9, lines 38-49 (requiring the user to store documents in the corporate directory database for automatic retrieval by the controller). If the user were allowed to specify a remote storage device there would be no need to first store documents in the corporate directory database before accessing those documents at the multifunction device. *See, e.g.*, col. 10, lines 49-56; col. 11, lines 1-12 and 20-21 (clarifying that the remote datastore is predetermined and not user-specified). Czyszczewski fails to disclose a user-specified remote storage device.

For at least the foregoing reasons claim 21 is believed to be allowable over the cited references and Applicant respectfully requests withdrawal of the rejection of claim 21.

Claims 22-27 depend from claim 21, which is believed to be allowable. Therefore, claims 22-27 are also believed to be allowable for at least the same reasons as claim 21 and withdrawal of the rejection of claims 22-27 is respectfully requested.

Claim 26 is also believed to be allowable for at least the same reasons as discussed above for claim 5.

**Conclusion**

The Applicant respectfully requests that a timely Notice of Allowance be issued in this matter.

Respectfully Submitted,

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